

REJECTION UNDER 35 U.S.C. § 103

The Examiner rejects claims 1-10, 12, 14, 16-18, 20-22, and 30-34 under 35 U.S.C. § 103(a) over U.S. Patent No. 5,482,704 to Sweger and U.S. Patent No. 6,277,893 to Babenko in view of U.S. Patent No. 5,919,438 to Saint-Leger and U.S. Patent No. 5,720,964 to Murray. Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Moreover, there must be a reasonable expectation of success. M.P.E.P. § 2143 (8th ed. 2001). Applicants respectfully submit that the Examiner has not satisfied these criteria.

The Examiner relies on the primary references, Sweger and Babenko, for teaching a cosmetic composition comprising the claimed at least one amphoteric starch. (Office Action at 2-3.) In particular, Sweger teaches various lotion compositions comprising CEPA potato starch, and cyclomethicone or dimethicone. (Examples II-IV.) These lotion compositions do not contain the claimed washing base. Moreover, Sweger does not teach or suggest a detergent composition.

Babenko teaches emulsions containing a cationic polysaccharide and dimethicone copolyol in an oil phase. (Abstract.) Babenko does not teach a composition comprising a specific combination of amphoteric starch, silicone, washing base, and cationic polymer. Moreover, Babenko teaches away from adding a washing base, such as a surfactant, because "classical type surfactants or emulsifying agents

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[which] can cause skin irritation or allergic reactions and [also] may not be compatible with other constituents." (Babenko, col. 1, lines 28-32.)

The Examiner relies on the secondary references, Saint-Leger and Murray, for teaching the claimed at least one cationic polymer and the claimed at least one silicone. (*Id.* at 3.) Based on these teachings, the Examiner argues that one of ordinary skill in the art would have been motivated to make the claimed invention because "the starch derivatives have excellent aesthetic properties of skin feel and appearance" and because "[t]he employment of the particular ingredients herein ...is obvious ... because all these ingredients are old and well-known cosmetic ingredients." (*Id.*)

In essence the Examiner's rejection is based on selective picking and choosing from each of several references in order to create the claimed invention, while impermissibly ignoring the art as a whole. *In re Wesslau*, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965) (holding that "[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art."). Such a rejection is improper under *The Gillette Co. v. S.C. Johnson & Son, Inc.*, 16 U.S.P.Q.2d 1923 (Fed. Cir. 1990).

In *Gillette*, the Federal Circuit rejected several arguments that a four-component shaving composition, which differed from a prior art composition only with respect to a single element (an oil-soluble jellifying agent in the prior art (Bluard) composition and a water-soluble gelling agent, such as cellulose-based polymers, in Johnson's claimed composition), was obvious. They did so by rejecting arguments focused on mere substitutions of components and alleged generalized advantages.

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First, the Court held that although all four of Johnson's claimed components were known, "[w]hat was not known or suggested, however, was the composition that resulted from the combination of those components, and its unique properties." *Gillette* at 1928. Thus, an argument "[f]ocusing on the obviousness of substitutions and differences, instead of the invention as a whole, is a legally improper way to simplify the often difficult determination of obviousness." *Gillette* at 1927 (citations omitted). Second, the Court rejected the "argument that other art-recognized advantages of cellulose-based polymers, namely lubricity and consistency enhancement, provide the 'suggestion' sufficient to motivate the art worker to substitute them for Bluard's [oil-soluble jelling agent]. This theory boils down to no more than hindsight reconstruction" *Gillette* at 1929.

Similarly, in the present case, what was not known was a composition comprising, a washing base, at least one amphoteric starch chosen from the compounds of formulae (I) to (IV), at least one cationic polymer, and at least one silicone, and its unique properties. Thus, as in *Gillette*, even though the claimed components are known individually, the claimed composition is not obvious based on unsupported mixing and matching of known components.

Moreover, it is not sufficient to merely "find every element of a claimed invention in the prior art [and for] an examiner to use the claimed invention itself as a blue print for piecing together elements Such an approach would be an illogical and inappropriate process by which to determine patentability." *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998) (citations and quotations omitted). The Examiner can meet the burden of establishing a *prima facie* case of obviousness "only by showing some objective

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teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (internal citations omitted) (emphasis added); *In re Sang-Su Lee*, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) ("The factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.").

However, the Examiner has not carried the burden of establishing an objective teaching or suggestion to combine the two primary references with the two secondary references. More specifically, there are at least the following deficiencies in the Examiner's position.

"When determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *In re Beattie*, 24 U.S.P.Q.2d 1040, 1042 (Fed. Cir. 1992) (quotations and citations omitted). However, in the present case, there is no evidence (or even allegation) that there would have been a motivation for the proposed substitution other than the mere possibility of substitution of components, which is not a motivation, *Gillette* at 1929. Moreover, one of the primary references, Babenko, specifically teaches that surfactants cause skin irritation and allergic reactions when used in cosmetic compositions, and thus teaches away from using surfactants as a washing base in a cosmetic composition.

The Federal Circuit has held that evidence of a teaching, suggestion, or motivation to combine may not flow from applicant's disclosure. *In re Vaeck*, 20

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U.S.P.Q.2d 1438 (Fed. Cir. 1991). That is, it is impermissible to rely on an applicant's own disclosure and to use hindsight to reconstruct the claimed invention. For example, the Examiner may not rely on Applicants' disclosure for the specific selection of surfactants as a washing base for use in a cosmetic composition also comprising at least one amphoteric starch, at least one cationic polymer, and at least one silicone.

The Federal Circuit's holding in *In re Geiger*, 2 U.S.P.Q.2d 1276 (Fed. Cir. 1987), which addresses impermissible hindsight reconstruction, is applicable to the present situation. In *Geiger*, the application claimed a method of inhibiting scale formation on and corrosion of metallic parts in cooling water systems by use of compositions containing three specified components. The collective prior art taught using each of these three components, separately or in a combination falling short of that claimed, for treating cooling water systems. The Board of Patent Appeals and Interferences held it *prima facie* obvious to combine the three components together for their known functions and to optimize the amount of each. *Id.* at 1277-78.

The Federal Circuit reversed the Board, emphasizing that "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." *Id.* at 1278. The court then proceeded to go through each of the references relied on showing why, absent hindsight, the skilled artisan would not have found it obvious to make the claimed composition.

While acknowledging that combining the three components of the claimed composition may have been obvious to try, the court stated it does not constitute the

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standard for combining references under section 103. *Id.*; cf. *In re Wesslau*, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965).

In the present case, but for the disclosure of the present application, there is no evidence of record suggesting the Examiner's proposed combination. As held in *Geiger*, it is impermissible to rely on applicant's disclosure for guidance in selecting components or combining references. Therefore, in accordance with the holding in *Geiger*, a *prima facie* case of obviousness has not been established in this application.

In sum, the references appear to separately teach individual elements of the claimed invention; however, no reference appears to teach or suggest the combination of the four specific components from amongst all the possible components for use in a cosmetic composition. The Examiner has not cited on the record the specific teaching or suggestion that would have motivated one of ordinary skill in the art to make all the specific selections needed to arrive at the claimed invention. Moreover, the Examiner has not established that a reasonable expectation of success exists in making the claimed invention; especially in view of the teaching away of using surfactants in Babenko and the art recognized problems associated with cationic polymers and silicones. See, e.g., Mougin et al. (U.S. Patent No. 6,166,093) and Melby (WO 98/44012).

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

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Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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